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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,926	01/31/2001	Kenichi Ishiguri	202678US2	9947
22850	7590	06/25/2004	EXAMINER PHAM, THOMAS K	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			ART UNIT 2121	

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,926

Applicant(s)

ISHIGURI, KENICHI

Examiner

Thomas K Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/31/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

First Action on the Merits

1. Claims 1-5 of U.S. Application 09/772,926 filed on 01/31/2001 are presented for examination.

Quotations of U.S. Code Title 35

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim Rejections - 35 USC § 102

4. Claim 5 is rejected under 35 U.S.C. 102(a) as being anticipated by Japanese Patent No. 11-205458 ("Yashihiro").

Regarding claim 5

Yashihiro teaches an e-mail communication terminal apparatus to be connected, by radio, to an e-mail system that is limited in an amount of data that can be communicated at one time (abstract), comprising: division control means for dividing transmission data into divisional data based on a predetermined data amount when the transmission data has an amount larger than the communicable data amount of the e-mail system (page 3, paragraph 13), and radio transmitting means for transmitting the divisional data produced by said division control means (page 3, paragraph 15).

Claim Rejections - 35 USC § 103

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent No. 11-074930 ("Sadao") in view of Japanese Patent No. 11-032196 ("Masafumi").

Regarding claim 1

Sadao teaches an e-mail communication terminal apparatus to be connected to an e-mail system comprising: division control means for dividing transmission data into divisional data (page 2, paragraph 7); transmitting means for transmitting the divisional data produced by said division control means (page 2, paragraph 8); receiving means for receiving data (page 4, paragraph 24); and recombination control means for recombining the data received by said receiving means when the data are divisional data that were separated from each other by a transmission source (page 4, paragraph 24). Sadao does not teach an e-mail system that is limited in an amount of data that can be communicated at one time, and dividing the data based on a predetermined data amount when the transmission data has an amount larger than the communicable data amount of the e-mail system. However, Masafumi teaches an e-mail system that is limited in an amount of

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data that can be communicated at one time (page 2 paragraph 7), and dividing the data based on a predetermined data amount when the transmission data has an amount larger than the communicable data amount of the e-mail system (page 3, paragraphs 10 and 11) for the purpose of transmitting large electronic mails to a network that only accepts small electronic mails. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a email size determination system of Masafumi with the email communication terminal of Sadao because it would provide for the purpose of transmitting large electronic mails to a network that only accepts small electronic mails.

Regarding claim 2

Sadao teaches information adding means for adding division information to the divisional data produced by said division control means, wherein the recombination control means recombines, based on division information, received divisional data to which the division information is added (page 4, paragraph 25).

Regarding claim 3

Sadao teaches the division information includes information indicating that the transmission data is divisional mail (page 4, paragraph 26).

Regarding claim 4

Sadao teaches the division information includes information indicating recombination order (page 4, paragraph 26).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (703) 305-7587 and fax number is (703) 746-8874, Monday-Thursday and every other Friday from 7:30AM- 5:00PM EST or contact Supervisor *Mr. Anthony Knight* at (703) 308-3179.

Any response to this office action should be mailed to: **Director of Patents and Trademarks Washington, D.C. 20231**, or **Hand-delivered** responses should be brought to **Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist located on the 4th floor)**, or fax to the **official fax number (703) 872- 9306**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Thomas Pham
Patent Examiner

TP

June 21, 2004



Anthony Knight
Supervisory Patent Examiner
Group 3600